



09-25-06

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
GILBERT P. HYATT) Group Art Unit: 2189
Serial No.: 06/848,017) Examiner: Reginald Bragdon
Filed: June 6, 1995)
Docket No.: 307)
For: AN INTEGRATED CIRCUIT FILTER)
PROCESSOR)
)

PETITION UNDER 37 CFR 1.181(A)(3)
CONCERNING A REQUIREMENT FOR INFORMATION
UNDER 37 C.F.R. § 1.105

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

This is a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director. The Applicant respectfully petitions for intervention of the Director regarding a Requirement For Information under 37 CFR 1.105.

RELIEF REQUESTED

The Applicant requests the following relief:

A determination that the Requirement For Information Under 37 CFR § 1.105 dated March 21, 2006 is not proper requirements for information under 37 CFR § 1.105 and that it be withdrawn.



STATEMENT OF THE FACTS INVOLVED

The following three papers are involved in this petition:

1. Requirement For Information Under 37 CFR § 1.105 dated March 21, 2006 (hereinafter "105 Requirement").
2. Response To The Requirement For Information Under 37 CFR § 1.105 dated September 21, 2006 (hereinafter "105 Response").
3. Telephone Conference Record of a telephone conference between the Applicant and the Examiner on September 6, 2006.

These papers are incorporated by reference into this petition as if fully provided as attachments hereto.

The 105 Requirement required a response to three stipulations and a large number of interrogatories. The three stipulations were ambiguous, indefinite and unintelligible and each required a single "agree" or "disagree" response even though they were hopelessly compound with different parts requiring different answers. In the event the Applicant disagreed with the Examiner's statement in the stipulations further responses had to be provided. The interrogatories were overly burdensome and served little if any legitimate purpose.

Stipulation 1 referred to a diagram which was apparently created by the Examiner purporting to reflect the Applicant's claim to benefit of priority patent applications which stated:

1. Attached "Exhibit A" is a correct representation of Applicant's claim for priority under 35 U.S.C. § 120 based on Applicant's statements on pages 37-40 of the amendment received 30 July 1990.

Stipulation 2 related to different kinds or uses of computer memories and stated:

2. The terminology "alterable memory" (e.g. claim 102), "random access memory" (e.g. claim 5), and "operand memory" (e.g. claim 104) as used throughout the claims refers to the same memory and are in fact just different labels with no patentable distinctions and therefor are equivalent structures.

Stipulation 3 related to different kinds or uses of computers and stated:

3. The terminology "integrated circuit digital signal processor" (e.g. claim 42), "single integrated circuit chip having a digital

"signal processor" (e.g. claim 53), and "monolithic integrated circuit data processor" (e.g. claim 164) as used throughout the claims refers to the same "single-chip" processor and are in fact just different labels with no patentable distinctions and therefore are equivalent structures.

The interrogatories listed a large number of different claim phrases and required the Applicant to "indicate the specific page and line numbers and/or figure(s) (with reference to specific elements within the figure(s) that provide support for the limitation" for the instant application and for each ancestor application.

The telephone conference effectively changed Stipulation 1. The Examiner stated that he only wanted the Applicant to confirm that the priority pages of the amendment received 30 July 1990 were correct. See the Telephone Conference Record.

The telephone conference also effectively changed Stipulations 2 and 3. The original Stipulations required consideration of a list of terms according to four qualifiers listed at the end. The qualifiers are (1) refers to the same memory and (2) are in fact just different labels (3) with no patentable distinctions and (4) therefore are equivalent structures. The Examiner changed Stipulation 2 and 3 in the telephone conference where he stated that he would accept as a sufficient response a statement that each of the individual terms in the stipulation were known in the prior art. The telephone conference thus redefined what was required by the three stipulations.

Contemporaneous with this Petition the Applicant is filing a 105 Response, which responds to the stipulations as redefined in the 105 Requirement and telephone conference and further objects to the entire requirement as being an improper requirement under 37 U.S.C. § 1.105. The requirement is objected to, *inter al.*, as being overly burdensome, calling for opinion, being ambiguous, being misleading, being indefinite, being unintelligible and being compound. The Applicant's 105 Response provides responses to the Stipulations in view of the redefining of the Stipulations by the Examiner.

ARGUMENT

I. THE APPLICANT OBJECTS TO STIPULATION 1

The Applicant objects to Stipulation 1 set forth in the 105 Requirement as being ambiguous and misleading and not requesting the information sought by the Examiner. The original Stipulation 1 in the 105 Requirement provided:

Attached "Exhibit A" is a correct representation of Applicant's claim for priority under 35 U.S.C. § 120 based on Applicant's statement on pages 37-40 of the amendment received 30 July 1990.

The Applicant responded to Stipulation 1 the best that he could under the circumstances. In the telephone conference, the Examiner told the Applicant that he wanted the Applicant to make a simple statement that the priority pages of the specification were correct. However, Stipulation 1 was not withdrawn by the Examiner. It still stands with the original wording, which is different from the interpretation of the Examiner. The Stipulation is thus ambiguous and misleading and much different from the information actually sought by the Examiner.

To assure a complete response, the Applicant has had to respond to both forms of the stipulation because the Examiner did not withdraw the original stipulation. For this reason and for the other reasons discussed herein, Stipulation 1 should be withdrawn.

II. THE APPLICANT OBJECTS TO STIPULATION 2

The Applicant objects to Stipulation 2 as being hopelessly compound, calling for a legal opinion, ambiguous, indefinite and unintelligible (discussed below). It is thus requested that the requirement be deemed improper and that the stipulation be withdrawn

Stipulation 2 in the 105 Requirement lists several memory terms which are the same in some implementations and different in other implementations. Yet Stipulation 2 demands a single unqualified answer as to (1) whether the terms as used throughout the claims refer to the same memory, (2) whether the terms are in fact just different labels, (3) whether the terms

have no patentable distinctions, and (4) whether the terms therefore are equivalent structures (the “four qualifiers”). A single “agree” or “disagree” answer was demanded even though there are many combinations of different answers as each different pair of terms is applied to each of these four qualifiers at the end of the request.

The requirement to consider the terms “as used throughout the claims” is indefinite since the terms may be used differently in different claims. Without reference to the way a specific term is used in a specific claim there can be no meaningful response to the stipulation.

Further, the comparisons have no single “agree” or “disagree” answer. For example, the first two terms were “alterable memory” and “random access memory”. Some alterable memories are random access memories while others are not. The same applies to most of the other pairs of terms. There is no single “agree” or “disagree” answer even though such was demanded.

Stipulation 2 demands to know in a single “agree” or “disagree” answer whether there are patentable distinctions between the terms. However, patentable distinctions must be determined in the context of each claim as a whole and in the context of the prior art and cannot be determined by looking at pairs of terms in isolation. Furthermore, whether or not there are patentable distinctions calls for a legal opinion that is not the proper subject matter for a 37 C.F.R. 1.105. *See* the discussion herein regarding the impropriety of seeking opinions in a 37 C.F.R. 1.105 Requirement.

Stipulation 2 also demands to know whether all of the terms are equivalent structures. This demand is indefinite, unintelligible and calls for a legal opinion. There is no definition of what “equivalent” is supposed to mean or what “structure” is supposed to mean. In the sense that all of the terms refer to memories that store data and without definitions, they may be considered to have somewhat equivalent structures on a very general level. In the sense that memories were implemented in different ways and performed different functions (e.g., static storage or dynamic storage, random access or sequential access, and integrated circuit construction or discrete component construction), they may be considered to have different structures. Thus, they all have potentially different structures and, on a very general level, may have potentially the same structures. For example, an alterable memory might or might not be an integrated circuit memory. The Applicant does not know what test to apply to determine if they are “equivalent structures”. The term could refer to the doctrine of

equivalents for determining infringement. Such a determination must be made on a claim by claim basis and involves a legal opinion that requires a given infringement context. It cannot be made in the abstract. Such an opinion is inappropriate under 37 C.F.R. 1.105 in the present context. *See* the discussion herein regarding the impropriety of seeking opinions in a 37 C.F.R. 1.105 Requirement.

The Applicant was required to “ascertain whether there are any differences of any significance among these terms and how such differences are to be attributed”. The Applicant is required to point out the differences between the terms (if any) and how these differences are supported in the specification, or the prior art at the time the invention was made.” *See* 105 Requirement at page 3.

The requirement is indefinite since not even a hint was provided as to what constitutes a significant difference. As pointed out, most of the terms might have differences and might have similarities. All have similarities in that they are memories. The Applicant responded in a reasonable manner considering that the Stipulation does not define what constitutes a significant difference between various terms.

The Applicant was further required to point out how the differences are “supported in the specification, or in the prior art.” Again, not a hint is provided as to what is meant by supporting a difference. This requirement is unintelligible. Further, there is no basis for the assumption that the differences are in fact supported in either the disclosure or the prior art, much less in a reasonable way that can be determined without excessive burden, yet the Applicant was required to show where this support was to be found.

Even more compelling is the issue of alternative embodiments which the Applicant advised the Examiner about in the telephone conference. Now that the Examiner recognizes that the application discloses alternative embodiments, it becomes clear as to why the Applicant responded as he did. It is fundamental to the law on alternative embodiments that alternative embodiments have differences but are often used to perform the same purpose. Thus, there is no “agree” or “disagree” to a stipulation as to whether they are equivalent, particularly when the central terms discussed above such as differences, equivalent, and support are not defined and there is no guidance given.

It is requested that the stipulation be deemed improper as to form and withdrawn because it is compound, indefinite, unintelligible and calls for a legal opinion.

III. THE APPLICANT OBJECTS TO STIPULATION 3

The Applicant objects to Stipulation 3 as being hopelessly compound, calling for a legal opinion, ambiguous, indefinite and unintelligible (discussed below). It is thus requested that the requirement be deemed improper and that the stipulation be withdrawn.

Stipulation 3 in the 105 Requirement lists several processor terms which are the same in some implementations and different in other implementations. Yet Stipulation 3 demands a single unqualified answer as to (1) whether the terms as used throughout the claims refer to the same memory, (2) whether the terms are in fact just different labels, (3) whether the terms have no patentable distinctions, and (4) whether the terms therefore are equivalent structures (the “four qualifiers”). A single “agree” or “disagree” answer was demanded even though there are many combinations of different answers as each different pair of terms is applied to each of these four qualifiers at the end of the request.

The requirement to consider the terms “as used throughout the claims” is indefinite since the terms may be used differently in different claims. Without reference to the way a specific term is used in a specific claim there can be no meaningful response to the stipulation.

Further, the comparisons have no single “agree” or “disagree” answer. For example, the first two terms were “integrated circuit digital signal processor” and “single integrated circuit chip having a digital signal processor”. Some alterable integrated circuit digital signal processors are single integrated circuit chip digital signal processor while others are not. A digital signal processor is not a single integrated circuit chip, whether or not the chip has a digital signal processor. The same applies to most of the other pairs of terms. There is no single “agree” or “disagree” answer even though such was demanded.

Stipulation 3 demands to know in a single “agree” or “disagree” answer whether there are patentable distinctions between the terms. However, patentable distinctions must be determined in the context of each claim as a whole and in the context of the prior art and cannot be determined by looking at pairs of terms in isolation. Furthermore, whether or not there are patentable distinctions calls for a legal opinion that is not the proper subject matter for a 37 C.F.R. 1.105. *See* the discussion herein regarding the impropriety of seeking opinions in a 37 C.F.R. 1.105 Requirement.

Stipulation 3 also demands to know whether all of the terms are equivalent structures. This demand is indefinite, unintelligible and calls for a legal opinion. There is no definition of what “equivalent” is supposed to mean or what “structure” is supposed to mean. In the sense that all of the terms refer to processors and without definitions, they may be considered to have somewhat equivalent structures on a very general level. In the sense that processors were implemented in different ways and performed different functions they may be considered to have different structures. Thus, they all have potentially different structures and, on a very general level, may have potentially the same structures. The Applicant does not know what test to apply to determine if they are “equivalent structures”. The term could refer to the doctrine of equivalents for determining infringement. Such a determination must be made on a claim by claim basis and involves a legal opinion that requires a given infringement context. It cannot be made in the abstract. Such an opinion is inappropriate under 37 C.F.R. 1.105 in the present context. *See* the discussion herein regarding the impropriety of seeking opinions in a 37 C.F.R. 1.105 Requirement.

The Applicant was required to “ascertain whether there are any differences of any significance among these terms and how such differences are to be attributed”. The Applicant is required to point out the differences between the terms (if any) and how these differences are supported in the specification, or the prior art at the time the invention was made.” *See* 105 Requirement at page 3.

The requirement is indefinite since not even a hint was provided as to what constitutes a significant difference. As pointed out, most of the terms might have differences and might have similarities. All have similarities in that they are memories. The Applicant responded in a reasonable manner considering that the Stipulation does not define what constitutes a significant difference between various terms.

The Applicant was further required to point out how the differences are “supported in the specification, or in the prior art.” Again, not a hint is provided as to what is meant by supporting a difference. This requirement is unintelligible. Further, there is no basis for the assumption that the differences are in fact supported in either the disclosure or the prior art, much less in a reasonable way that can be determined without excessive burden, yet the Applicant was required to show where this support was to be found.

Even more compelling is the issue of alternative embodiments which the Applicant advised the Examiner about in the telephone conference. Now that the Examiner recognizes that the application discloses alternative embodiments, it becomes clear as to why the Applicant responded as he did. It is fundamental to the law on alternative embodiments that alternative embodiments have differences but are often used to perform the same purpose. Thus, there is no "agree" or "disagree" to a stipulation as to whether they are equivalent, particularly when the central terms discussed above such as differences, equivalent, and support are not defined and there is no guidance given.

It is requested that the stipulation be deemed improper as to form and withdrawn because it is compound, indefinite, unintelligible and calls for a legal opinion.

IV. OBJECTIONS TO THE 37 CFR 1.105 REQUIREMENT FOR INFORMATION

The Applicant objects to the instant Requirement for Information because it violates the policies and procedures of the PTO. For example; it violates MPEP 704.11, 704.11(b), and 704.14 and it violates the Federal Register – Rules and Regulations that relate to the instant Requirement For Information; as discussed below. Examples are provided below.

1. The PTO requires that a Requirement For Information be "focused", "specific", "concise", and "limited [in] scope". See MPEP 704.11 and see the Federal Register, Vol. 69, No. 182, pages 56511 et seq. However, the instant Requirement For Information is neither "focused", nor "specific", nor "concise", nor "limited [in] scope".
2. The PTO prohibits a Requirement For Information from placing an "undue burden" on the Applicant. See MPEP 204.11 and see the Federal Register, Vol. 69, No. 182, pages 56511 et seq. However, the broad nature of the instant Requirement For Information improperly places the prohibited "undue burden" on the Applicant.
3. The PTO prohibits a Requirement For Information from seeking an applicant's "opinion". See the Federal Register, Vol. 69, No. 182, pages 56511 et seq. However, the instant Requirement For Information improperly seeks the Applicant's "opinion".

The Applicant further objects to the instant Requirement For Information because it violates MPEP 704.11. In particular; “the scope of the requirement” has not been “narrowly defined” nor “narrowly specified and limited in scope” and the Examiner does not have “a reasonable basis for requiring [the] information” and thus, “[I]t is a significant burden on both the applicant and the Office”. *See* MPEP 704.11:

704 What Information May Be Required ...

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

INFORMATION REASONABLY NECESSARY FOR FINDING PRIOR ART

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary in the examination or treatment of a matter in an application. The information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the relevant prior art; the examiner must make a search of the art according to MPEP § 704.01 and §§ 904 – 904.03.

The criteria of reasonable necessity is generally met, e.g., where: ...

The statement then goes on to give two examples where “the claimed subject matter cannot be adequately searched” or where there is a “lack of relevant prior art found in the examiner’s search”; neither of which are the situation in the instant case.

Further, the information sought in the Requirement is not “reasonably necessary” nor “narrowly defined”, it is a substantial effort that is not focused on the instant claim limitations. *See also* MPEP 704.11, 704.14:

704.14 Making a Requirement for Information

A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope. It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

In particular; “the scope of the requirement” has not been “narrowly defined” nor “narrowly specified and limited in scope”, the Examiner does not have “a reasonable basis for requiring [the] information”, and “[I]t is a significant burden on both the applicant and the Office”.

The PTO prohibits a Requirement For Information from seeking an applicant's “opinion”. *See* the Federal Register Vol. 69, No. 182, page 56512, cols. 1-2 (emphasis added):

The terms “factual” and “facts” are included in the rule to make it clear that it is facts, and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are being sought, and that requirements under § 1.105(3)(3) **are not requesting opinions** that may be held or would be required to be formulated by applicant.... Applicant need not, however, derive or independently discover a fact ... in response to a requirement for information.

See also the Federal Register Vol. 69, No. 182, page 56513, col. 3:

Response[To Comment 67]: To the extent that such comments are directed toward the elucidation of opinions and legal conclusions, the comments are adopted and the rule has been amended to remove the term “opinion”.

See also Federal Register Vol. 69, No. 182, page 56514, col. 1 (emphasis added):

Response[To Comment 72]: The comment is adopted to the extent that interrogatories and stipulations **should not be used to ask for opinions**, and that examiners will receive training in the drafting of **concise, focused** interrogatories and stipulations.

See also Federal Register Vol. 69, No. 182, page 56514, col. 3 (emphasis added):

Comment 77: Several comments suggested that the proposed amendment to § 1.105 would be particularly onerous on *pro se* inventors.

Response[To Comment 77]: The comment has been adopted to the extent that the comments were directed towards requiring submission of opinion evidence, e.g., the level of ordinary skill in the art. Thus, this final rule making clarifies that **“opinion evidence” shall not be encouraged to be sought by a § 1.105 requirement.**

However, the instant Requirement For Information improperly seeks the Applicant's "opinion" and is far from "concise" and "focused". *See also* Federal Register Vol. 69, No. 182, page 56514, col. 1 (emphasis added):

Response [To Comment 72]: The comment is adopted to the extent that interrogatories and stipulations **should not be used to ask for opinions**, and that examiners will receive training in the drafting of **concise, focused** interrogatories and stipulations.

V. **THIS REQUIREMENT FOR INFORMATION IS PART OF A PATTERN OF SUCH IMPROPER REQUIREMENTS, WHICH IS INAPPROPRIATE AND SHOULD BE ENDED**

This Requirement For Information is part of a pattern of such requirements, which is inappropriate. This Requirement For Information is being misused (Federal Register Vol. 69, No. 182, page 56513, col. 1 (emphasis added)):

Requirements for information are not routinely made. They are to be used only where there is an absence of necessary information within the record. Any such requirement should be tailored to treat specific issues on a case-by-case basis.

However, this and other Requirements For Information are being “routinely made” in various ones of the Applicant’s copending applications, the requirements are not being made “on a case-by-case basis”. For example, such Requirements For Information were made in 26 of the Applicant’s applications within the same art group (Group 2100) within a six week period. This violates the fundamental basis of 37 CFR 1.105 and the PTO’s commitments to the public.

This is even more troubling because four of these applications have been finally rejected, briefed, answered, replied to, heard by the Board, decided by the Board, and Reheard by the Board. Then, early in 2005, the Examiner reopened prosecution and generated 105 Requirements similar to the 105 Requirement addressed herein in all four of these Board-decided cases. Even more significant is the fact that the rejections of most of the claims at issue in these four Board-decided cases, effectively all of the claims at-issue in the Board-decided cases, have been reversed by the Board but are now under 105 Requirements for the second time since the Board rendered its decisions. Furthermore, the Board specifically addressed the issues of (1) priority and (2) § 112-1 rejections which are now at issue in (1) Stipulation 1 and (2) Stipulation 2, respectively. Essentially, the Examiner appears to be seeking a method for reversing the Board’s decisions.

There appears to be no reason for this 105 Requirement. The terminology that is at issue here has been in the prior art for more than 25 years and is admitted known to the Examiner. It is not obscure terminology in an abstract art, it is very well known terminology in a very well known art.

During the “rulemaking” in the Federal Register, the PTO promised the profession that it had petition relief was available regarding improper 105 Requirements. However, the Examiner herein informed the Applicant that he would not stay the two month time period if the Applicant filed petitions. Even more troubling, the Applicant did file petitions to withdraw the 105 Requirements in the four Board-decided applications yet the six month maximum extension period has run without the Applicant receiving a response to these petitions. This seems to indicate that the PTO’s promise to the profession about petition relief for improper 105 Requirements is to no effect.

These 105 Requirements are so poorly worded and ambiguous that they are virtually impossible to respond to. They impose an extreme burden on the Applicant while producing very little useful information for the examination process.

This burden does not end with a single ambiguous, unintelligible 105 Requirement. A 105 Requirement had previously been generated in all four of the Board-decided applications early in 2005.

Thus, for these reasons alone, this 105 Requirement should be withdrawn to put an end to this burdensome and apparently never-ending process regarding this Applicant.

VI. RELIEF REQUESTED

The pattern of never-ending 105 Requirements regarding this Applicant must be brought to an end. This can only be done by withdrawing this improper 105 Requirement.

Further, the Stipulations are hopelessly compound, indefinite, ambiguous and improperly call for opinions of the Applicant. Further, the Stipulations do not require the information that the Examiner now is seeking. As result they should be ruled improper as to form and withdrawn.

Notwithstanding the fact that there is no fee requirement for this Petition, for an abundance of caution the Applicant is providing a fee authorization. Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626. A Declaration claiming small entity status has been filed herein.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number EV 748457955 on September 21, 2006.

Respectfully submitted,

Dated: September 21, 2006



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